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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,259	12/30/2005	Horst Wisniewski	H0075.70107US00	5101

23628 7590 10/07/2008  
WOLF GREENFIELD & SACKS, P.C.  
600 ATLANTIC AVENUE  
BOSTON, MA 02210-2206

EXAMINER
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NGUYEN, PHONG H

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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10/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/542,259	<b>Applicant(s)</b> WISNIEWSKI, HORST	
	<b>Examiner</b> PHONG H. NGUYEN	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23 and 27-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 23 and 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (5,865,358) in view of Gold (3,086,365).

Regarding claim 23, Fernandez teaches a workpiece cracking device comprising a base 54, a first pair of jaws (left member 42) immovably mounted on the base, a second pair of jaws (right member 42) movably mounted to the base and a drive (80 & 82) for moving the second pair of jaws. See Fig. 5.

Fernandez does not teach a control unit with the frequency and the reciprocating force of the second pair of jaws being adjustable.

Gold teaches an actuation rod 15 similar to the actuation rod 86 in Fernandez wherein the frequency and the reciprocating force of the rod are adjustable by a control unit. See Fig. 1.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to incorporate the actuation rod of Gold into the cracking device of Fernandez so that a user can control the frequency and the cracking force of the actuation rod.

Regarding claims 27 and 28, the free ends of the pairs of jaws are best seen in Fig. 5 in Fernandez.

Regarding claim 29, since the spaced apart ends of the pairs of jaws in Fig. 2 are considered "cutting edges", the spaced apart ends of the pairs of jaws in Fernandez are considered "cutting edges".

Regarding claims 30 and 31, the cracking device of Fernandez is capable of cracking a disk shaped workpiece. When the right jaw pair 42 pivots in the B-direction, the end of the jaw pair would form an angle of about 5 degrees with respect to the radius of the workpiece.

Regarding claim 32, Gold teaches the hydraulic system comprising a pump 4, a valve 6 and an actuator cylinder 15.

Regarding claims 33 and 34, the valve 5 is controllable.

Regarding claim 35, as Gold's hydraulic system is incorporated into the Fernandez's device, the cylinder's 15 in Gold replaces the cylinder 86 in Fernandez.

Regarding claim 36, the cylinder 86 being connected to the base is best seen in Fig. 5 in Fernandez.

### ***Response to Arguments***

3. Applicant's arguments filed 07/01/2008 have been fully considered but they are not persuasive.

The Applicant argues that Fernandez teaches a rapid clean break but not the material being slowly worn down by an alternative load in the decisive area. This argument is not persuasive. The Applicant does not clearly describe how a workpiece is

broken. Therefore, Fernandez's teaching reads on claim 23. The second pair of jaws in Fernandez moves up and down periodically to break a workpiece. Therefore, it meets the limitation of "moving periodically to and fro". It appears that the Applicant tries to incorporate the limitations in the Specification into the claim. The Applicant is reminded that though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment. *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004).

The Applicant argues that Gold does not teach a second pair of jaws. This argument is not persuasive. Gold is applied to show that the use of a control system is well known in the art. Therefore, the combination of Fernandez and Gold teaches all the limitations of claim 23.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3724

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHONG H. NGUYEN whose telephone number is (571)272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy V Eley/  
Primary Examiner, Art Unit 3724

/P. H. N./  
Examiner, Art Unit 3724  
September 29, 2008